



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,601	10/11/2000	Franco Lo Giudice	198404US0	5262
22850	7590	04/14/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER ZIMMER, MARC S	
			ART UNIT 1712	PAPER NUMBER
DATE MAILED: 04/14/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/685,601	Applicant(s) GIUDICE ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-13,15,17-22 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-7,9,11,24 and 30-35 is/are allowed.
- 6) ☒ Claim(s) 2,3,12,13,18,21,22,25,26,28 and 29 is/are rejected.
- 7) ☒ Claim(s) 15,17,19,20 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant has furnished evidence illustrating that, where the molecular weight of a polymer is recited but there is no indication as to whether it is a number-average molecular weight or a weight-average molecular weight, one of ordinary skill will presume that it is a number-average molecular weight that is being reported. Accordingly, the rejection under 35 U.S.C. 112, first paragraph is hereby withdrawn.

In a modified survey of the prior art, the Examiner discovered additional references that render unpatentable at least some of the claims. Any inconvenience this may have caused Applicant is sincerely regretted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-3, 12-13, 18, 21-22, 25-26, and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al., U.S. Patent # 4,938,910. In the abstract is described a polymer composition containing one of materials (A), (B), or (C), and a polymer derived from 4-methyl-1-pentene. Relevant to the present discussion, one embodiment of (C) is squalane, or 2, 6, 10, 15, 19, 23-hexamethyltetracosane, according to column 4, line 56 through column 5, line 28. Squalane may be added to the polymer in amounts as little as 2 parts to 98 parts of the polymer.

Pigments and other adjuvants are contemplated in column 6, lines 12-17.

Methods of preparing mixtures of the polymer and squalane are mentioned in column 6, lines 3-11.

Allowable Subject Matter

Claims 15, 17, 19-20, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach combinations of a branched hydrocarbon additive and a polysiloxane having a molecular weight exceeding 500,000 amu. Also, Abe doesn't teach the addition of squalane to any polymer other than that derived from 4-methyl-1-pentene

Claims 1, 4-7, 9, 11, 24, and 30-35 are allowable for the same reason.

Ebert et al., U.S. patent # 6,706,797 describes a composition similar to those outlined in a number of the claims wherein the polymer to which the branched hydrocarbon is added is polycarbonate but this reference does not antedate the effective filing date of the present application. DE 3841609 A describes a lubricating oil comprising, among other materials, squalane and a polysiloxane oil. However the viscosity of the latter reflects a polymer having a number-average molecular weight far below 500,000.

Art Unit: 1712

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 6, 2006



MARC S. ZIMMER
PRIMARY EXAMINER